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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/617,371

07/10/2003

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03/22/2006

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EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/617,371

Applicant(s)

YAMAZAKI ET AL.

Examiner

Francisco C. Prats

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-13 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-20-04</u> . | 6) <input type="checkbox"/> Other: ____.  |

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**DETAILED ACTION**

The preliminary amendment filed July 10, 2003, has been received and entered.

Claims 11-13 and 15-24 are pending and are examined on the merits.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in

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order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-13 and 15-24 are rejected under 35 U.S.C.

§ 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Moorhouse (*Industrial Polysaccharides: Genetic Engineering, Structure/Property Relations and Applications*, M. Yalpani, ed., Elsevier, 1987, pages 187-206) or Kang (U.S. Pat. 3,915,800) or Pollock (U.S. Pat. 5,854,034).

Each of the cited references discloses polysaccharide products, in pure form, which appear to be identical to the presently claimed products, based on the fact that the prior art products have chemical structures identical to the chemical structures of the claimed polysaccharides. See Moorhouse, at page 189, disclosing gellan gum, welan gum, rhamsan gum, and polysaccharides S-657, S-88 and S-198; see also Kang, at column 14, lines 8-26 and column 18, lines 1-8, disclosing the purification of applicant's claimed polysaccharide "S-7" (termed "Heteropolysaccharide-7" therein); see also Pollock, e.g., at Fig. 6, disclosing gellan gum, welan gum, rhamsan gum, and NW-11, as recited in the claims.

Note specifically that the processes of making the polysaccharides do not change the structures of those products.

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Moreover, according to applicant's specification at page 11, the claimed "slime form" of the polysaccharides requires only that the "polysaccharide [which] is not attached to the producing bacterial cell and [which] can be substantially separated from cells by sedimentation or centrifugation of the fermentation broth or after aqueous dilution of the broth, and in the absence of heat treatment, or other physical or chemical treatments of the broth." The purified forms of the polysaccharides disclosed in the cited references have been separated from the cells that produced them, and are therefore "not attached" to the cells, as required by the definition of "slime form" in the specification. Also, because they are already purified, the purified forms of the polysaccharides disclosed in the cited references can be readily separated from producer cells. Thus, despite the fact that the prior art products are made by bacteria which may be different than the bacteria which produce the claimed products, the products are outwardly identical in structure. Consequently, the claimed products appear to be anticipated by the cited references.

However, even if the reference products and the claimed products are not one and the same and there is, in fact, no anticipation, the reference products would, nevertheless, have rendered the claimed product obvious to one of ordinary skill in

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the art at the time the claimed invention was made in view of the fact that one of ordinary skill would have reasonably expected nominal differences in the structures of polysaccharides produced by different fermentation batches, depending on the conditions used to prepare the polysaccharides. Thus the claimed invention as a whole was clearly *prima facie* obvious especially in the absence of sufficient, clear, and convincing evidence to the contrary.

Note that MPEP § 2113 states that:

. . . [w]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (1972).

MPEP § 2113 also clearly states that

The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature than when a product is claimed in the conventional fashion. *In re Fessmann*, 180 USPQ 324 (CCPA 1974)."

Thus, it is clear that the alternative-type rejection set forth herein is explicitly authorized by the MPEP.

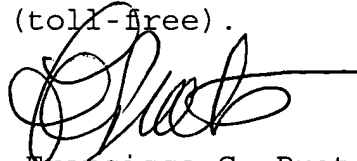
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No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C. Prats whose telephone number is 571-272-0921. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Francisco C. Prats  
Primary Examiner  
Art Unit 1651

FCP